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| 10/092,892 | 03/06/2002 | Kazuhiko Momoki | 1232-4834 | 1144 |

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| EXAMINER |
|---|
| THOMPSON, TIMOTHY J |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2873 | |

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/092,892 | MOMOKI, KAZUHIKO | |
| | Examiner | Art Unit | |
| | Timothy J Thompson | 2873 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6-9 and 11* is/are rejected.

7)☒ Claim(s) *2,5 and 10* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inabara et al.(U.S. Patent No. 4,906,078) in view of Yanari(U.S. Patent No. 6,377,399).**

Regarding claims 1 and 3, Inabara et al. discloses an objective optical part which forms an image of an object(fig 2, G1, G2, G3), and has a first lens unit with a negative power(fig 1, G1) and a second lens unit with a positive power arranged from an object side in the order named(fig 1, G2), said second lens unit being capable of moving in a direction(fig 1); an image inverting part which converts an image formed by said objective optical part into an erect image(fig 1, P); and an eyepiece optical part which guides the erect image converted by said image inverting part to an observer(fig 1, EP). Inabara et al. does not disclose the second lens unit being capable of moving a component perpendicular to an optical axis to stabilize an image. However, Yanari discloses a second lens unit being capable of moving a component perpendicular to an optical axis to stabilize

an image(fig 1, L2). It would have been obvious to one skilled in the art, at the time of the invention, to move the second lens unit perpendicular to an optical axis as shown by Yanari, in the optical system of Inabara et al., since as shown by Yanari, the second lens unit is commonly moved perpendicular to an optical axis so as to stabilizile the image due to shaking or moving of the lens unit.

**Claims 1, 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakagami et al.(U.S. Patent No. 5,617,159) in view of Onuki(U.S. Patent No. 6,377,305).**

Regarding claim 1, Sakagami et al. discloses an objective optical part which forms an image of an object(fig 1, 2, 3), and has a first lens unit with a negative power(fig 1, 2) and a second lens unit with a positive power arranged from an object side in the order named(fig 1, 3), said second lens unit being capable of moving in a direction including a component perpendicular to an optical axis to stabalize the image(col 5, line 65 to col 7, line 13). Sakagami et al. does not specifically disclose an image inverting part which converts an image formed by said objective optical part into an erect image and an eyepiece optical part which guides the erect image converted by said image inverting part to an observer. However, Onuki discloses an image inverting part(fig 1, 142) which converts an image formed by said objective optical part into an erect image and an eyepiece optical part(fig 1, 143) which guides the erect image converted by said image inverting part to an observer. It would have been obvious to one skilled in the art, at the time of the invention, to use an image inverting part which

converts an image formed by said objective optical part into an erect image and an eyepiece optical part which guides the erect image converted by said image inverting part to an observer as shown by Onuki, in the optical system of Sakagami et al., since as shown by Onuki, an image inverting part which converts an image formed by the objective optical part into an erect image and an eyepiece optical part are commonly used for guiding an erect image to the user of a camera for indicating the image that will be captured on film of the camera.

Regarding claim 4, Sakagami et al. discloses second lens unit can swing about a point on the optical axis(fig 1, 9 and col 5, lines 44-55).

Regarding claim 11, Sakagami et al. discloses observation optical system(col 7, lines 24-27).

**Claims 1, 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker(U.S. Patent No. 2,985,071) in view of Yanari(U.S. Patent No. 6,377,399) and Inabara et al.(U.S. Patent No. 4,906,078).**

Regarding claims 1, Becker discloses an objective optical part which forms an image of an object(fig 1), and has a first lens unit with a negative power(fig 1, r5-r7) and a second lens unit with a positive power arranged from an object side in the order named(fig 1, r11-r12). Becker does not disclose said second lens unit being capable of moving in a direction including a component perpendicular to an optical axis to stabilize the image; an image inverting part which converts an image formed by said objective optical part into an erect

image; and an eyepiece optical part which guides the erect image converted by said image inverting part to an observer. Regarding the movement of the second lens, Yanari discloses a second lens unit being capable of moving a component perpendicular to an optical axis to stabilize an image(fig 1, L2). It would have been obvious to one skilled in the art, at the time of the invention, to move the second lens unit perpendicular to an optical axis as shown by Inabara et al., in the optical system of Yanari, since as shown by Inabara et al., the second lens unit is commonly moved perpendicular to an optical axis so as to stabilizile the image due to shaking or moving of the lens unit. Regarding the eyepiece and the erecting element, However, Onuki discloses an image inverting part(fig 1, 142) which converts an image formed by said objective optical part into an erect image and an eyepiece optical part(fig 1, 143) which guides the erect image converted by said image inverting part to an observer. It would have been obvious to one skilled in the art, at the time of the invention, to use an image inverting part which converts an image formed by said objective optical part into an erect image and an eyepiece optical part which guides the erect image converted by said image inverting part to an observer as shown by Onuki, in the optical system of Sakagami et al., since as shown by Onuki, an image inverting part which converts an image formed by the objective optical part into an erect image and an eyepiece optical part are commonly used for guiding an erect image to the user of a camera for indicating the image that will be captured on film of the camera.

Regarding claim 6, Becker discloses first lens unit consists of one positive

lens element(fig 1, r5-r6) and one negative lens element(fig 1, r6-r7), and the second lens unit having of one positive lens element(fig 1, r11-r12).

Regarding claim 7, Becker discloses a first lens unit (fig 1, r5-r7) has a positive lens element(fig 1, r5-r6) with a convex surface facing the object side and a negative lens element(fig 1, r6-r7) with a concave surface facing the image side which are arranged from the object side in the order named(fig 1).

Regarding claim 8, Becker discloses a first lens unit(fig 1, r5-r7) having of a lens component formed by cementing the positive lens element(fig 1, r5-r6) to the negative lens element(fig 1, r6-r7)(see the table which shows that the lens elements are cemented together).

Regarding claim 9, Becker discloses the second lens unit(fig 1, r11-r12) having of a positive lens element having a convex surface facing the object side(see the table which shows that the positive lens elements has a convex surface facing the object). side).

***Response to Arguments***

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Regarding the combination of Inabara et al. and Yanari which combines an image stabilization function. Moving a lens perpendicular to the optical axis is commonly done so as to stabilize the image as shown by Yanari. Additionally, just because the second lens is being moved for focusing does not mean the lens cannot be moved perpendicular to the optical axis for image stabilization. Infact, this is commonly done as shown by Ohtake(U.S. Patent No. 6,339,509, col 10, lines 50-65) and is done so as to stabilize the image thus providing a clearer image too the viewer. Finally, shifting the second lens group into the complex optical system of Inabata with out affecting performance, or selecting the exact lens to move for image stabilization with out affecting performance is well within the skill of the art as evidenced by the fact that as in Yanari or Ohtake incorporating the stabilization mechanism and selecting the exact lens is never detailed in the patent indicating this is well within the skill of the art as evidenced by the lack of detail in the disclosure.

In this case, regarding the combination of Sakagami et al. and Onuki which combines an image stabilization function. Moving a lens perpendicular to the optical axis is commonly done so as to stabilize the image that that is the motivation for combining the two references. Additionally, a beam splitter would be used so as to provide light flux to both the eyepiece and the image capture device as shown by Onuki(fig 1, 132), using a beam splitter is well within the art for providing light to both the eyepiece and image capture device as shown by Onuki since a beam splitter would have to be used so that the camera would

function properly by providing light flux to both the eyepiece and the image capture device. Regarding, that the applicant states that the viewfinder is a separate optical system. Since Sakagami does not disclose the specific viewfinder system used, it would have been obvious to look to Onuki for a viewfinder system since a specific view finder was not disclosed by Sakagami and Onuki discloses a working view finder. Additionally, just because Sakagami states that the viewfinder is a separate optical system, it is still reasonable to look to a viewfinder which is not specifically separate, since Sakagami discloses a lens system without a specific viewfinder, it is reasonable for someone skilled in the art to use the viewfinder of Onuki in the lens system of Sakagami. Finally, since the specific power of the lenses are not disclosed in words, it is reasonable to look to the drawings which clearly indicate the powers of the lenses.

***Allowable Subject Matter***

Claims 2, 5, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With the important features being the mathematical limitation pertaining to focal length ratios or the antivibration sensitivity.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Thompson whose telephone number is (703) 305-0881. If the examiner can not be reached his supervisor, Georgia Epps, can be reached on (703) 308-4883.

Tim Thompson 2/19/04

T.J.T.

2/19/04